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QWEST COMMUNICATIONS INTERNATIONAL INC LAW DEPT INTELLECTUAL PROPERTY GROUP 1801 CALIFORNIA STREET, SUITE 3800 DENVER, CO 80202			LAZARO, DAVID R	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/672,398
Filing Date: September 28, 2000
Appellant(s): LANGDON, WARREN E.

Jeremy J. Curcuri (42,454)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/23/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the Appellant only argues the limitations of the independent Claims included in the group of Claims 1-5, 15-16 and 20. Each other group does not provide reason in support thereof as they rely on dependency to the independent Claims included in the group of Claims 1-5, 15-16 and 20 or refer to the reasons given for the group of Claims 1-5, 15-16 and 20. Because of this, the group of Claims 1-20 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,389,467

Eyal

5-2002

Computer Dealer News "New Products/systems: Yepp its an MP3 music player" Vol. 15
Issue 7, 03/31/2000, p.42

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

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Claims 1-5, 15, 16 and 20 rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on 02/23/04.

Claims 6 and 7 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 02/23/04.

Claims 7, 8, 18 and 19 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 02/23/04.

Claims 9-13 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 02/23/04.

Claim 14 rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 02/23/04.

(11) Response to Argument

With respect to the group including Claims 1-5, 15-16 and 20, the Appellant's arguments are focused on the limitations regarding the "portable wireless music player". More specifically, as stated from representative Claim 1, the limitations argued are

the portable wireless music player being only a relatively simple listening device with limited functionality so as not to be time critical in its operations

and

downloading music to the portable wireless music player from the music service provider in accordance only with the previously defined play list such that the

portable wireless music player is only a relatively simple listening device with

limited functionality so as not to be time critical in its operation (emphasis added).

Since the interpretation of these limitations is the basis for many of the arguments, the Examiner's interpretation is now given. Obviously, the device is portable and wireless and has the capabilities of playing music. The Examiner asserts the limitation '*being only a relatively simple listening device with limited functionality so as not to be time critical in its operations*' as being very broad and not explicit about the capabilities and specific functionalities of the "portable wireless music player". As stated in the eighth paragraph of MPEP 2106[R-2].II.C.,

"Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)."

In this case, the Appellant's specification lacks an explicit definition of this limitation. Neither the limitation as a whole or the individual components of the limitation ('*limited functionality*' and '*time critical*') are expressly defined in the specification or in any argument given by the Appellant.

While the Appellant's specification discusses "no need for" expensive devices such as PDAs (Page 4, line 32 - Page 5 line 2), the Appellant's specification does not expressly state these devices are not used. The Appellant's specification also states on Page 10, lines 23-27,

"While embodiments of the invention have been illustrated and described, it is not intended that these embodiments illustrate and describe all possible forms of the invention. Rather the words used in the specification are words of description

rather than limitations, and it is understood that various changes may be made without departing from the spirit and scope of the invention."

As such, one could consider devices with limited functionality, such as PDAs or other "thin clients", to be within the scope of the invention as claimed. PDAs and similar devices are generally considered "thin clients" in that they have limited functionality when compared to a regular client such as desktop PC or even a laptop. The limited functionality of these devices is usually the result of their smaller size, which in general, restricts or places limits on components such as power, memory, and processing capabilities.

The scope of the invention was further determined through the claim language itself. The Examiner interprets '*a relatively simple listening device*' as being a device '*with limited functionality so as not to be time critical in its operations*'. The Examiner interprets '*limited functionality*' as having, at minimum, the functionality to perform the functions stated in the claims and optionally other functions as long as they do not make the operations of the device '*time critical*'. The '*time critical*' limitation is simply interpreted as an operation not dependent on time.

Based on this reasoning, the basic functions that have to be performed by the "portable wireless music player" based on the claim limitations are as follows: connecting to a music service provider over a wireless service network, downloading music based on a predefined play list, and playing that music. These basic functions are stated in each of the independent Claims. The Examiner does not interpret the '*limited functionality*' necessarily limiting the device to these basic functions since other

possible functionalities are presented in the Appellant's specification such as paging, short messages, and voice mail (See page 4 lines 21-22 and Page 5 line 6 of the Appellants Specificaliton) and since the Appellant makes note of other possible embodiments and that "*various changes may be made*" on page 10 lines 23-27 of the Appellants specification. The Examiner also notes the transitional phrase "comprising" is used in all the independent claims.

Based on the interpretation of the claim limitations being argued, the Examiner will now explain how the teachings of the reference Eyal are within the scope of these limitations.

Eyal describes a system that enables one to define a play list through interaction on one device (Col. 31 lines 61-64) that can later be accessed by a different device (Col. 32 lines 17-19). The Examiner interprets this different device as being a "portable wireless music player" as claimed. This is based on the descriptions given by Eyal of the network enabled device and the operational environment (See Col. 10 lines 34-65, Col. 13 lines 46-64, and Col. 33 lines 51-64 for the general areas that will now be discussed). The basic device implemented by Eyal (generally called a "network enabled device" or "user terminal" by Eyal) is a portable (an example device is handheld - Col. 10 lines 56-57), wireless (Col. 10 line 53-56), music player (Col. 10 lines 64-65 - note: media includes music Col. 1 lines 22-25), that can connect to a music service provider over a wireless service network (Col. 13 lines 58-64 and Col. 10 lines 34-38), and download music based on a predefined play list (Col. 32 lines 17-19). The

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descriptions of the network enabled device do not include any explicit or implied teachings of any operations being time critical. Thus, Eyal teaches a '*portable wireless music player*' that at minimum has the basic functions claimed by the Appellant.

Furthermore, Eyal states the device can be "any internet enabled multimedia computing platform" (Col. 13 lines 45-49) or a "wireless access protocol (WAP) enabled device" (Col. 33 lines 51-64). The Examiner contends that the scope of these types of devices would include, a "portable wireless music player" device that is '*a relatively simple listening device with limited functionality so as not to be time critical in its operations*'.

The Examiner notes that this explanation of Eyal based on the interpretation of the claim language responds directly to the argument presented in the first paragraph on Page 8 of the Appeal Brief. The Appellant argues that there is no support for the Examiner's interpretation of Eyal disclosing a device with the minimum functionality required to access a predefined play list and play back the play list such that scope of Eyal would include a device with '*limited functionality so as not to be time critical in its operations*'. The Examiner contends the interpretation of Eyal is supported based on the explanation of Eyal just given.

The Examiner will now address the individual arguments and statements made by the Appellant.

From pages 5-6 of the Appeal Brief, in the first paragraph, the Appellant argues "*Particularly worth noting is the fact that with the portable wireless music player*

comprehended by the invention, there is no need for an expensive personal computer, personal digital assistant or cellular phone, but instead, a simple portable listening device may be utilized. This is in direct contrast to the relied upon reference..."

The Appellant's argument is based on page 4, lines 16 through page 5 line 6 of their specification. The examiner first notes that this section of the specification does not actually state '*a simple portable listening device*'. This section only states '*a portable listening device*'. Furthermore, this section in the Appellant's specification states '*no need for*' expensive devices such as PDAs but does not expressly state these devices are not used. Even considering that some aspects of the Appellant's specification may imply a portable wireless music player that excludes certain devices, the subject matter as claimed does not make the same exclusion. As stated in the eighth paragraph of MPEP 2106[R-2].II.C.,

"Limitations appearing in the specification but not recited in the claim are not read into the claim. > E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364,1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily)."

Also in regards to the claimed subject matter, the Appellant states from the argument that '*a simple portable listening device may be utilized*'. This is not the device that is claimed. What is claimed is a "*portable wireless music player being only a relatively simple listening device with limited functionality so as not to be time critical in its operations*" (from representative claim 1). The Examiner does not see the direct

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contrast the Appellant is arguing. The basic device implemented by Eyal (generally called a "network enabled device" or "user terminal" by Eyal) can be a portable (one example device is handheld - Col. 10 lines 56-57), wireless (Col. 10 line 53-56), music player (Col. 10 lines 64-65 - note: media includes music Col. 1 lines 23-25). At minimum, the functionality of this music player as taught by Eyal allows the music player to connect to a music service provider over a wireless service network (Col. 13 lines 58-64 and Col. 10 lines 34-38), and download music based on a predefined play list (Col. 32 lines 17-19) and playback the music (Col. 10 lines 64-65). The descriptions of the network enabled device do not include any explicit or implied teachings of any operations being time critical. As such, this portable wireless music player disclosed Eyal would be within the scope of the claimed limitations.

From page 6 of the Appeal Brief, in the second paragraph, the Appellant first states the general arrangement of their invention and then argues it is *"in contrast to Eyal wherein the Internet-enabled computing platform interfaces with a server module to achieve searching and the playing of media from play lists"*.

The Examiner does not see the contrast between the arrangement of Eyal and the arrangement of the Appellant. The Appellant provides no explanation of their interpretation of Eyal and why the teachings of Eyal are in contrast to the Appellant's invention.

The Appellant's states in this paragraph that in their invention *'a play list is defined at the music service provider through user interaction at a remote client'*. As

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stated in this argument by the Appellant, Eyal does use an Internet-enabled computing platform to interface with a server module. In this case, the Internet-enabled computing platform of Eyal (Col. 13 lines 46-53) is the "remote client" through which the user interacts to define a play list at the server module (Col. 31 lines 61-63), which is the "music service provider". In Eyal, the play list is stored and later accessed by any user terminal (Col. 32 lines 15-19). Hence, the music can be downloaded to the user terminal, which in this case is a portable wireless music player (as interpreted and explained above), in accordance with a previously defined play list.

While Eyal does include a searching function in some embodiments, other embodiments don't rely on the search function. Furthermore, the claim language uses the transitional phrase "comprising". The MPEP states in the second paragraph of 2111.03 [R-2], *"The transitional term 'comprising', which is synonymous with 'including,' 'containing,' or 'characterized by,' is inclusive or open-ended and does not exclude additional, unrecited elements or method steps."* Thus, additional functionality is not excluded by the claims.

Base on these reasons, Eyal is not in contrast to the claimed limitations.

From page 7 of the Appeal Brief, in the first paragraph, the Appellant argues the devices of Eyal are *"far different than the recited relatively simple listening devices with limited functionality required by Claim 1"*. Appellant makes the same argument in the third paragraph of page 7 of the Appeal Brief.

The Appellant fails to explain exactly how Eyal's devices are "far different". For instance, the Appellant does not argue how the devices disclosed by Eyal are not limited in functionality or how they are "time critical" in their operations. The Appellant mentions the title and abstract of Eyal refer to search functionality at the network enabled device (Page 7 of Appeal Brief, first paragraph). As stated before, not all embodiments of Eyal rely on the search functionality. Even considering certain embodiments of Eyal where the search functionality may be at the network enabled device, the Appellants use of the transitional phrase "comprising" does not necessarily exclude this functionality. Furthermore, the Appellant does not argue how the search functionality relates to '*limited functionality*' or being '*time critical*'. The Appellant's specification also offers no guidance in terms of any relationship concerning a search functionality and '*limited functionality*' or being '*time critical*'. Appellant presents a similar argument concerning the search functionality in the first paragraph of Page 8 of the Appeal Brief.

The Appellant also states that Eyal discusses data management, but the Appellant does not argue as to how this relates to '*the portable wireless music player being only a relatively simple listening device with limited functionality so as not to be time critical in its operations*'. None the less, one would have to expect some sort of data management in a system such as the one claimed by the Appellant where a particular user defines a play list through one device and later accesses the same play list using a different device. Without data management, how would a particular user's play list be distinguished by the system such that the user's portable wireless music

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player would be able to access the correct predefined play list. The Examiner notes that on page 8 of the Appeal Brief, in the second paragraph, the Appellant briefly comments on the statements made by the Examiner on page 13, in paragraph 34 of the Final Rejection but does not respond to these statements. The Examiner's statements in the Final Rejection were also directed towards the same argument of "data management" and addressed in a similar manner as just presented.

The Appellant ends the first paragraph on page 7 of the Appeal brief by stating "there is no suggestion to modify" the devices of Eyal. No suggestion is needed as Eyal expressly presents the basic device with the minimum functions needed (Col. 10 lines 34-66), and further states any properly configured device would be sufficient (Col. 13 lines 45-49 and Col. 33 lines 51-64). As stated early, the Examiner asserts this would include the *'the portable wireless music player being only a relatively simple listening device with limited functionality so as not to be time critical in its operations'* as claimed. The Examiner notes this argument concerning "no suggestion to modify" is presented again by the Appellant in the first paragraph on page 8 of the Appeal Brief.

In the arguments presented in both the first and third paragraph of Page 7 of the Appel Brief, the Appellant focuses on the exemplified devices of Eyal being "a PC, PDA, cell phone or Palm PC" as being "*far different*". The examiner notes that Eyal also discloses other devices not addressed by the Appellant that can be used as the network enabled device such as "handheld devices" (Col. 10 lines 56-58), "smart appliances" (Col. 10 lines 60-63), and "smart phones, and Internet enabled televisions and radios, and other devices" (Col. 13 lines 49-52). These devices include, in some forms,

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devices that are "portable wireless music players" with *'limited functionality so as not to be time critical in its operations'*. This is implied based on Eyal's teachings of a portable (Col. 10 lines 56-57), wireless (Col. 10 line 53-56), music player (Col. 10 lines 64-65) with the minimum functionality to allow the music player to connect to a music service provider over a wireless service network (Col. 13 lines 58-64 and Col. 10 lines 34-38), download music based on a predefined play list (Col. 32 lines 17-19) and playback the music (Col. 10 lines 64-65). Eyal also does not describe any explicit time critical operations in relation to the exemplified devices. The Appellant makes no arguments concerning the differences between these other exemplified devices of Eyal and the Appellant's device.

Based on these reasons, the devices of Eyal are not "far different" from those required by the claims.

From page 7 of the Appeal Brief, in the second paragraph, Appellant only states Eyal teaches play lists can be accessed from any one of a plurality of terminals that have access to the system (based on Col. 32 lines 17-19 of Eyal).

The Examiner agrees and further argues that such a terminal taught by Eyal includes a "portable wireless music player" (Col. 10 lines 34-66, Col. 13 lines 45-49 and Col. 33 lines 51-64) that is within the scope of the Appellant's claims.

From page 7 of the Appeal Brief, fourth paragraph, Appellant argues the use of WAP enabled devices by Eyal is "far different than the claimed invention".

The Examiner disagrees as the cited section (Col. 33 lines 51-64 of Eyal) states "an example of a distributed architecture playback system includes wireless devices that are communicatable to a network containing media resources." The Appellant's invention is also a distributed architecture playback system as a user interacts through a remote client (such as a desktop computer) to define a play list and later accesses it through a portable wireless music player. The portable wireless music player is a wireless device that can communicate to a network containing media resources (an explicit claim limitation). A WAP enabled device is given as an example of a wireless device. The Examiner notes that WAP stands for Wireless Access Protocol and is used in conjunction with handheld computers which have memory and CPU constraints (which limits functionality). The Examiner contends that the scope of WAP enabled devices would include a "portable wireless music player" device that is '*a relatively simple listening device with limited functionality so as not to be time critical in its operations*'. The Appellant does not explain how all WAP enabled devices are "far different" with respect to the specific claim language.

From page 8 of the Appeal Brief, in the third paragraph, the Appellant again argues "*Eyal does not imply or suggest the use of relatively simple listening devices with limited functionality so as not to be time-critical in operation in the specific combination to achieve the claimed invention.*"

The Examiner first notes the Appellant did not fully quote the Examiner's statement from paragraph 35 of the Final Rejection. In paragraph 35 of the Final Rejection, the Examiner stated

"Eyal implies that other devices, such as those with limited functionality so as not to be time critical in their operations (Col. 10 lines 48-65), can be used to access pre-defined play lists as long as they can access the network, receive communications and playback the music (Col. 32 lines 17-19)."

The meaning of this statement refers back to the interpretation of Eyal based on the interpretation of the claim language. Specifically, to be within the scope of the limitations, the minimum functionality of the device as taught by Eyal must allow the device to connect to a music service provider over a wireless service network (Col. 13 lines 58-64 and Col. 10 lines 34-38), and download music based on a predefined play list (Col. 32 lines 17-19) and playback the music (Col. 10 lines 64-65). The descriptions of the network enabled device do not include any explicit or implied teachings of any operations being time critical. The device is further defined as a portable (one example device is handheld - Col. 10 lines 56-57), wireless (Col. 10 line 53-56), music player (Col. 10 lines 64-65 - note: media includes music Col. 1 lines 23-25).

Based on these reasons, Eyal does imply and suggest the use of relatively simple listening devices with limited functionality so as not to be time-critical in operation.

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From page 9 of the Appeal Brief, in the first paragraph, Appellant comments on the lack of motivation to modify Eyal based on the article provided by the Examiner discussing the Samsung Internet music player.

The Examiner considers the Samsung Internet music player to be a portable, limited functionality music playing device with network connection capabilities (connects to the Internet). The Examiner, in presenting this article, was not attempting to form a rejection of any of the claims. The Examiner presented the article to establish that at the time of the invention of Eyal, a relatively simple, portable wireless music player with limited functionality so as not to be time critical, existed in some form. The existence of this device makes it logically reasonable to interpret Eyal as including such a device or teaching a similar device. As such, the article provides additional support to the Examiner's interpretation of Eyal, but it is not required in regards to the actual rejections applied.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



David Lazaro
September 10, 2004

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